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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/665,973	09/18/2003	Quang Tran	006701.P035	5340
8791 7590 01/30/2009 BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP 1279 OAKMEAD PARKWAY SUNNYVALE, CA 94085-4040				
			EXAMINER	
			DIXON, ANNETTE FREDRICKA	
			ART UNIT	PAPER NUMBER
			3771	
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			01/30/2009 PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/665,973

Applicant(s)

TRAN ET AL.

Examiner

Annette F. Dixon

Art Unit

3771

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 28-35 and 37-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 28-35 and 37-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This Office Action is in response to the amendment filed on February 29, 2008. Examiner acknowledges claims 28-35 and 37-44 are pending in this application, with claims 1-27, 36, and 45-54 having been cancelled.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 28-35 and 37-44 are rejected under 35 U.S.C. 102(e) as being anticipated by Lowe et al. (6,709,667).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

As to claim 28, Lowe discloses a system for delivering a contraceptive device within a fallopian tube, the system comprising: a catheter (fig. 1, 20,16) comprising: an elongate tubular catheter body (see fig.1) having a proximal (toward 30 in fig.1) portion adjacent a proximal end (fig.1, 32), a distal portion (fig.1 depicts the distal end of the catheter) adjacent a distal end, and at least one lumen (fig.1 depicts that structure 18 is contained within a lumen); at least one coil (fig.3, 56) disposed along the catheter body nearer the distal end than the proximal end and encircling the lumen (see fig.3); wherein the distal portion inherently has varying degrees of flexibility determined by constraining the coil and is adapted to couple to a contraceptive device (and a contraceptive device (fig.1,12) releasably disposed at least partially within the lumen of the catheter near the distal portion (see release catheter 16 in col.8, line 15); and a deployment member (fig.1, 18) in detachable (18 is threaded, see col.8, lines43 and 44, thus can be detachable) engagement with the contraceptive device for deploying the contraceptive device from the catheter.

As to claim 29, Lowe discloses a system as in claim 28, wherein the distal portion of the catheter body is more flexible towards the distal end of the catheter body than towards the proximal end (the distal portion is inherently more flexible due to the coil composition, see col.10, lines 54-68).

As to claim 30, Lowe discloses a system as in claim 29, wherein the distal portion of the catheter body comprises multiple layers (figs. 1 and 3, reference objects 14, 50, and 56), and the at least one coil comprises one of the layers (see fig.3).

As to claim 31, Lowe discloses a system as in claim 30, wherein the multiple layers comprise: an inner layer (see fig.3, 50); a middle layer (fig.3, 56); and an outer layer (fig.1, 14).

As to claim 32, Lowe discloses a system as in claim 31, wherein the middle layer comprises the coil (see fig.3).

As to claim 33, Lowe discloses a system as in claim 32, wherein the coil comprises at least one material selected from the group consisting of nickel-titanium alloy, stainless steel, titanium and a polymer (in col.18, lines 68 Lowe discloses the coil can be stainless steel).

As to claim 34, Lowe discloses a system as in claim 31, wherein the inner layer comprises at least one material selected from the group consisting of polytetrafluoroethylene, etched polytetrafluoroethylene and a fluoropolymer (col.18, lines 57-68, and col.19, lines 1-16).

As to claim 35, Lowe discloses a system as in claim 31, wherein the outer layer comprises at least one polyurethane material(col.18, lines 57-68, and col.19, lines 1-16).

As to claim 37, Lowe discloses a system as in claim 29, wherein the distal portion comprises: a first segment (fig.1B, 30); and at least a second segment (fig.1, 20) distal to the first segment, wherein the second segment is more flexible than the first segment (the second segment deflects in to the uterus while the first segment stays outside of the uterus, thus the deflection nature makes the second segment more flexible than the first segment, see figs.11B).

As to claim 38, Lowe discloses a system as in claim 37, further comprising a third segment (fig.1, 24) distal to the second segment, wherein the third segment is more flexible than the second segment

As to claim 39, Lowe discloses a system as in claim 38, wherein the distal portion comprises: an inner layer (fig.3, 50); a middle layer (fig.3, 56); and an outer layer (fig.1, 14).

As to claim 40, Lowe discloses a system as in claim 39, wherein the middle layer comprises the coil (see fig.3) and the outer layer comprises at least one polyurethane material (col.18, lines 57-68, and col.19, lines 1-16).

As to claim 41, Lowe discloses a system as in claim 40, wherein the at least one polyurethane material comprises at least two polyurethane materials for conferring varying levels of flexibility to the distal portion(col.18, lines 57-68, and col.19, lines 1-16).

As to claim 42, Lowe discloses a system as in claim 40, wherein the at least one polyurethane material has an increasing amount of flexibility from a proximal end of the distal portion to the distal end of the distal portion(col.18, lines 57-68, and col.19, lines 1-16).

As to claim 43, Lowe discloses a system as in claim 28, wherein the proximal portion of the catheter body includes at least one visualization marker near the distal portion for enhancing visualization of a proximal-most end of the distal portion (col.7, lines 12-19).

As to claim 44, Lowe discloses a system as in claim 43, wherein the visualization marker comprises at least one radiopaque material (col.7, lines 12-19).

Response to Arguments

4. Applicant's arguments filed February 29, 2008 have been fully considered but they are not persuasive. Applicant asserts the prior art made of record does not disclose or teach a coil element that encircles a lumen. Examiner respectfully disagrees with Applicant's assertion. As shown in Figures 11H of Lowe, Lowe discloses a contraceptive apparatus having a catheter (14) comprising: an elongated tubular catheter body (16), and at least one lumen (18) where the lumen (18) is encircled by a coil (56), additionally, the contraceptive apparatus having a contraceptive device (12) and a deployment member (the threaded portion of lumen 18, Column 8, Lines 43-44) by which the contraceptive device (12) will detach from the catheter (14). Regarding the lumen limitation, there is no recitation within the claim language that sets forth structural limitations by which the lumen must extend. Because of this, the lumen portion of 18 may be construed as the portion by which the internal thread of the lumen 18 contacts the external threading of the contraceptive device by which the detachment of the two piece may occur. Thus, in light of the aforementioned reasoning the rejection of the claims has been maintained.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Sporri et al. (6,042,590 and 6,565,557) disclose additional fallopian tube occlusion methods but do not teach the deployment of a detachable member within the fallopian tube.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Annette F. Dixon whose telephone number is (571) 272-3392. The examiner can normally be reached on Monday thru Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Justine Yu can be reached on (571) 272-4835. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Annette F Dixon
Examiner
Art Unit 3771

/Annette F Dixon/
Examiner, Art Unit 3771

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